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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/917,995	07/30/2001	James S-B Spragins	SPRG1	9763

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LARRY J. GUFFEY  
WORLD TRADE CENER - SUITE 1800  
401 EAST PRATT STREET  
BALTIMORE, MD 21202

EXAMINER

NGUYEN, MAIKHANH

ART UNIT PAPER NUMBER

2176

DATE MAILED: 02/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/917,995	<b>Applicant(s)</b> SPRAGINS, JAMES S-B	
	<b>Examiner</b> Maikhanh Nguyen	<b>Art Unit</b> 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***DETAILED ACTION***

1. This action is responsive to communications: RCE filed 11/08/2005 to the original application filed 07/30/2001.
2. Claims 1-30 are currently pending in this application. Claims 1, 11, and 21 have been amended. Claims 1, 11, and 21 are independent claims.

***Request Continuation for Examination***

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/08/2005 has been entered.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary*

*skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

5. Claims 1-3, 7-8, 10-13, 17-18, 20-23, 27-28, and 30 are rejected under 35 U.S.C. 103(a) as being **Lewis et al.** (U.S. 6,611,802 filed 06/1999).

**As to claim 1**

- a. Lewis teaches a method that enable one to give feedback on an electronic writing created with a word processing software by another seeking the feedback and wherein the writing being displayable using the software on a video display of a computer system (*see the Abstract*), the method comprising the steps of:
- (i) developing a set of editorial markings that are insertable into the writing (*e.g., see the proofreading and correcting dictated text contained in an electronic document discussion, beginning at col.2, line 16 & col.3, line 1; see also fig. 3E and the associated text*);
  - (ii) selecting from the set of editorial markings a marking to be inserted into the writing (*e.g., selecting proofreading criteria for identifying textual errors contained in the electronic document; col.2, lines 16-28 & col.3, lines 1-19; see also fig. 3E and the associated text*);
  - (iii) inserting the marking into the electronic writing so as to create a version of said electronic writing that has inserted into said version at least of said insertable editorial markings (*e.g., see fig.4 and the accompanying text beginning at col.11, line 3*); and

- b. Lewis does not specifically teach the saving step as claimed. However, Lewis discloses “Apply” button (see fig. 3E).
- c. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied Lewis’s teachings to include the saving step as claimed because it would have provided the capability for storing all the grammar rules (*e.g.*, 27; *fig. 3E*) that will be used when editing the electronic document.

**As to claim 2**

Lewis teaches compiling summary statistics for the saved markings that communicate information pertaining to the use of the markings in the writing (*col.3, lines 20-28 & see fig.3G*).

**As to claim 3**

Lewis teaches filtering the inserted markings so that only a specified portion of such markings remain in the writing when it is returned to its writer (*col. 11, line 55-col.12, line 7*).

**As to claim 7**

Lewis teaches chosen from, among other things, the group consisting of capitalization (*e.g., capitalization; col.1, lines 40-52*).

**As to claim 8**

Lewis teaches the compiled summary statistics communicate information selected from, among other things, specified skills that the writer would need to focus upon in order to improve the writer's writing skills writer (*see the Abstract*).

**As to claim 10**

Lewis teaches the inserted marking having an associated editorial comment that is insertable in the writing (*col.3, lines 1-65 and see fig.3G*).

**As to claim 11**

It is directed to a computer program product for implementing the method of claim 1, and is similarly rejected under the same rationale.

**As to claims 12-13, 17-18, and 20**

They include the same limitations as in claims 2-3, 7-8, and 10, and are similarly rejected under the same rationale.

**As to claim 21**

It is directed to a system for performing the method of claim 1, and is similarly rejected under the same rationale.

**As to claims 22-23, 27-28, and 30**

They include the same limitations as in claims 2-3, 7-8, and 10, and are similarly rejected under the same rationale.

6. Claims 4-6, 9, 14-16, 19, 24-26 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Lewis et al.** in view of **Driscoll et al.** (U.S. 5,987,302 – issued 11/1999).

**As to claims 4-6, 14-16 and 24-26**

- a. Lewis does not explicitly teach “*hyperlinking the inserted marking to a website that exists on a network of linked computers.*”
- b. Driscoll teaches hyperlinking the inserted marking to a website that exists on a network of linked computers (*col.3, lines 8-10; col.7, lines 34-54; col.9, line 23-col.10, line 14 and see figs. 7-17*).
- c. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the feature Lewis in the system of Driscoll because it would have provided the capability for offering students the opportunity to prepare practice essays, submit the essays to trained, expert readers, and retrieve an evaluation at the student’s convenience.

**As to dependent claims 9, 19 and 29:**

- a. Lewis does not explicitly teach “*the website having information chosen from the group consisting of detailed explanations of the markings and exercises that one can undertake in order to strengthen those writing skills which are denoted by the inserted markings as representing areas in which the writer needs improvement.*”
- b. Driscoll teaches the website having information chosen from the group consisting of detailed explanations of the markings and exercises that one can undertake in order to strengthen those writing skills which are denoted by the inserted markings as representing areas in which the writer needs improvement (*col.4, lines 47-65/ col.6, line 50 – col.7, line 1*).
- c. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the feature Lewis in the system of Driscoll because

it would have provided the capability for providing useful instructional feedback to students about their skills relative to the assessment.

***Response to Arguments***

7. Applicants' arguments filed 11/08/2005 have been fully considered but are moot in view of the new ground(s) rejection.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- |   |   |                           |                       |
|---|---|---------------------------|-----------------------|
| - | Mogilevsky  | U.S. Patent No. 5,649,222 | Issued: Jul. 15, 1997 |
| - | Muranaga et al.   | U.S. Patent No. 5,671,428 | Issued: Sep. 23, 1997 |
| - | Moody et al.  | U.S. Patent No. 5,890,177 | Issued: Mar. 30, 1999 |
| - | Fein et al.   | U.S. Patent No. 5,940,847 | Issued: Aug. 17, 1999 |
| - | Hon et al.  | U.S. Patent No. 6,490,563 | Issued: Dec. 3, 2002  |
| - | Zhu et al.  | U.S. Patent No. 6,654,032 | Issued: Nov. 25, 2003 |
| - | Storisteanu et al.  | U.S. Patent No. 6,976,209 | Issued: Dec. 13, 2005 |
| - | D. Mason et al., "Providing Mark-up and Feedback to Students with Online Marking", ACM, March 1999, Vol.3 Issue 1, pp. 3-6. |                           |                       |
| - | G. Hardock et al., "A Marking Based Interface for Collaborative Writing", ACM, December 1999, pp. 259-266.                  |                           |                       |



- J. Wolfe, "Effects of Annotations on Student Readers and Writers", ACM, 2000, pp. 19-26.
- W. Willis, "New Assessment Tools Provide a Closer Look at Student's Mastery", Technology Horizons in Education, November 1996, pp. 1-5.


***Contact information***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached at (571) 272-4136.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MN

  
HEATHER R. HERNDON  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100